

REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner.

Claims 1-23 were pending in the instant application at the time of the outstanding Office Action. Of these claims, claims 1, 12, and 23 are independent claims; the remaining claims are dependent claims. Claims 8-10, and 19-21 are objected to as being unclear regarding the meaning of "at least one additional main body." Claims 1-3, 11-14, and 22-23 stand rejected 35 U.S.C. § 102(b) as being anticipated by Homma, U.S. Patent No. 5,584,395. Claims 4 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Homma in view of Jongen et al., U.S. Patent No. 6,433,336. Finally, claims 5-7 and 16-18 are found to be directed toward patentable subject matter, but objected to as being dependent upon a rejected base claim; thus, the claims are found to be allowable if rewritten in independent form.

Independent claims 1, 12, and 23 have been amended to essentially include the subject matter as set forth in claims 4 and 15, which have been cancelled. Dependent claims 5, 8, 16, and 19 have been amended to maintain proper dependency. Applicants intend no change in the scope of the claims by the changes made by this amendment. It should be noted these amendments are not in acquiescence of the Office's position on allowability of the claims, but merely to expedite prosecution.

Before discussing the rejections to the present claims, Applicants would like to address the objections to claims 8-10 and 19-21, which are objected to as being unclear regarding the meaning of "at least one additional main body." The Examiner asks

whether any such bodies are shown in the drawings. One preferred embodiment of the present invention comprises a "four-rotary wheel" method and apparatus as shown in Figure 2 and explained at pages 8-9. Thus in at least one embodiment of the present invention more than one main body can be used in combination with the other main bodies for automatically exchanging components in soft-error testing of computer chips. For the aforementioned reasons, Applicants respectfully submit the subject matter of claims 8-10 and 19-21 is fully supported by Applicants disclosure and distinctly claimed in light thereof. Thus, Applicants respectfully request the withdrawal of these objections.

As explained below, the present invention is not obvious in view of the applied art because all the necessary requirements to establish obviousness are not fully satisfied by the references. Not only is there a lack of support for finding a motivation and expectation of success to make the combinations and modifications suggested by the Office, importantly, the cited art fails to teach or suggest the instant invention as presently claimed. The immediate withdrawal of the present rejections and notice of allowance is, therefore, respectfully requested.

The present invention broadly relates to a method and apparatus for using and exchanging degraders, which are themselves used to step-down beam energies for computer chip testing. As indicated in the specification, the change from one degrader to another has required the manual manipulation of degraders, which possess various drawbacks including personal injury and exposure to harmful radioactive energy. At least one embodiment of the present invention allows for the non-manual manipulation and exchange of degraders.

The cited art stands in contrast to the presently claimed invention. As best understood, Homma appears to be directed toward "a high speed sorting apparatus for semiconductor device equipped with rotatable drum." (Title) It appears that chips are graded by a testing system, 12, and then deposited through a funnel chute, 11a, into a rotatable drum member, 11b, which then sorts and deposits the chips by grade into various storage boxes, 11j. As rightly noted by the Examiner Homma fails to teach or suggest any use of degraders. Therefore, the reference standing alone fails to teach or suggest all the presently claimed limitations of the present independent claims and therefore fails to anticipate the present invention as set forth in the independent claims, which recite, *inter alia*, components "wherein the components comprise beam degraders." However, the Examiner has indicated Jongen et al. relates to a degrader and therefore it would have been obvious for one skilled in the art to combine the teachings of the two references thereby making the presently claimed invention obvious under 35 USC 103(a). The Applicants most respectfully disagree that a *prima facie* case is thereby established.

As the Examiner is aware, to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 there must be: (1) a suggestion or motivation to modify a reference or combine references; (2) a reasonable expectation of success in making the modification or combination; and (3) a teaching or suggestion to one skilled in the art of all the claimed limitations of the invention to which the art is applied. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). It should be noted at the outset there appears to be no motivation set forth in the Office Action for the combination thus indicating the rejection should be withdrawn.

In any event, the Applicants would also like to suggest that such a motivation to make the combination, which should be evidenced by the references themselves, is not present. There is no motivation to combine one or more degraders with the Homma chip sorter. One skilled in the art would not expect the proposed combination to be successful in achieving the present invention; moreover, no useful purpose is served by such a combination and thus no motivation can be demonstrated. For example even if degraders could be attached to the sorting drum of Homma they would simply interfere with the sorting of chips being performed by the Homma invention. There is no indication of how an energy beam would or could be directed toward a degrader attached to a moving chip sorting drum in order to achieve the present invention. Because a motivation does not exist for combining these references; an expectation of success in making the combination is not present; and the combination if made would not actually meet the invention now under consideration, the Applicants again respectfully request the withdrawal of such rejections and that any similarly based rejections of the amended independent claims be withheld.

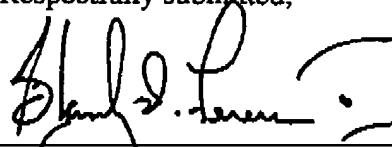
In view of the foregoing, it is respectfully submitted that independent claims 1, 12, and 23 are fully distinguishable over the applied art and are thus immediately allowable. By virtue of dependence from allowable independent claims, it is thus also submitted that claims 2, 3, 5-11, 13, 14, and 16-22 are also allowable at this juncture.

Applicants acknowledge that claims 5-7 and 16-18 were indicated by the Examiner as being allowable if rewritten in independent form. Applicants reserve the right to file new claims of such scope at a later date that would still, at that point, presumably be allowable.

The "prior art made of record" has been reviewed. Applicants acknowledge that such prior art was not deemed by the Office to be sufficiently relevant as to have been applied against the claims of the instant application. To the extent that the Office may apply such prior art against the claims in the future, Applicants will be fully prepared to respond thereto.

In summary, it is respectfully submitted that the instant application, including claims 1-3, 5-14, and 16-23, is presently in condition for allowance. Notice to the effect is hereby earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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